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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,143	01/12/2001	Jiangchun Xu	210121.427C23	2429

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EXAMINER

ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

16

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/759,143

Applicant(s)

XU ET AL.

Examiner

Shubo "Joe" Zhou

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2003 and 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,11 and 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,11,18,19,21,23,24,26-29,31,33,34 and 36 is/are rejected.
- 7) ☒ Claim(s) 20,22,25,30,32 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: Sequence Alignment between SEQ ID NO:110 and sequence 36 of US 6,130,043.

## **Detailed Action**

### ***Restriction/elections***

Applicants' election of Group I (claims 1, 3-4 and 11)) and the nucleotide sequence of SEQ ID NO:110 in Paper # 13, filed 2/10/03, are acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1, 3-4, 11, and 18-36 are currently pending and under consideration.

### ***Priority***

It is brought to applicants' attention that for the purpose of examination, priority has not been granted to four of the claimed prior applications: 09/030607, 09/020956, 08/904804 and 08/806099 for the elected invention because the Office has not been able to determine that the elected SEQ ID NO:110 was disclosed in the claimed applications. The earliest prior application where the sequence of SEQ ID NO:110 is found disclosed is 09/115,453, filed 7/14/1998. Prior art published after the filing dates of the four prior applications but before the filing date of 09/115,453 and that of the instant application may have been cited in this Office action. Applicants are requested to provide evidence that the elected invention is indeed disclosed in the prior application if they wish to contest the citation of the intervening prior art.

### ***Information Disclosure Statement***

The Information Disclosure Statements filed 1/12/01, 10/15/01, 10/22/01, and 5/15/02, respectively, have been entered and considered except those which were lined-through on the

PTO-1449 forms, where the references were not in English and no translations were provided. Initialed copies of the forms PTO-1449 are enclosed with this action.

### ***Specification***

The disclosure is objected to because of the following informalities:

Figure 12B is not described in the section of Brief Description of the Drawings or any part of the specification.

Appropriate correction is required.

### ***Claim Rejections-35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

**Claims 1, 3-4, 11, 18-19, 21, 23-24, 26-29, 31, 33-34, and 36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Billing-Medel et al. (US patent #: 6,130,043, pub. date: Oct. 10, 2000, filing date: May 1, 1998).**

Billing-Medel et al. disclose a polypeptide of 255 amino acids (sequence 36) which is encoded by a polynucleotide sequence(sequence 16). See column 41. The amino acid sequence is

also encoded by nucleotides 1178-1942 of the instantly claimed SEQ ID NO:110. See the attached sequence alignment.

Billing-Medel et al. also disclose polyclonal and monoclonal antibodies made with the polypeptide of sequence 36, thus the polypeptide is immunogenic. See columns 57-60. The polypeptide includes portions of 351-547, 351-472, 376-384, 370-379, 411-486, 306-322, 453-472, 463-472, 543-553 and 439-459 of the polypeptide (the instant SEQ ID NO:113) encoded by the instant SEQ ID NO:110.

Billing-Medel et al. also disclose vectors comprising the polynucleotide and host cells transfected with the vector. See column 56. Further, Billing-Medel et al. disclose compositions comprising an expression vector containing the polynucleotide of sequence 16, carrier PBS and enhancer Cardiotoxin for in vivo immunization. See columns 56-57.

Billing-Medel et al. also disclose an array of different vectors that can be used for containing the polynucleotides including viral vector such as adenovirus. See columns 26-28.

### ***Claim Objections***

Claims 20, 22, 25, 30, 32, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located

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in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

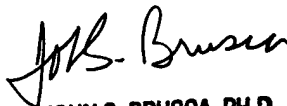
Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is 703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Shubo "Joe" Zhou, Ph.D.   
Patent Examiner

  
JOHN S. BRUSCA, PH.D  
PRIMARY EXAMINER